UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,598	12/15/2000	Scott Gerald Allam	7466/80497	1242

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EXAMINER
QUELER, ADAM M

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	**Applicant(s)**
		09/738,598	ALLAM ET AL.
Office Action Summary		**Examiner**	**Art Unit**	
		Adam M Queler	2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 October 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-58</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-58</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed 10/29/2004.

2.   Claims 1-58 are pending in the case. Claims 1, 44, 46, and 57 are independent claims.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1-4, 6-18, 21-28, 30-38, 42-47, 49-52 and 55-58 are rejected under 35**

U.S.C. 102(b) as being anticipated by Rivette et al. (US006018749A, filed 4/9/1998)

hereinafter Rivette-749.

Regarding independent claims 1, 44, 46, and 57, Rivette-749 teaches displaying in a first

window a physical page (Fig. 59). The window surrounding the text is the visual reference.

Rivette-749 teaches extracting the information on the physical page (col. 19, line 65 – col. 21,

line 11). Rivette-749 teaches presenting the extracted information in a second window and that

the information is free-flowing (Fig. 59).

Regarding dependent claim 2, Rivette-749 teaches the physical page is represented in an

electronic page view (Fig. 59).

Regarding dependent claim 3, Rivette-749 discloses that the physical page is represented as an

icon including a thumbnail of the physical page (Fig. 65).

Regarding dependent claim 4, Rivette-749 discloses the first and second windows are the same

window (Fig. 59, Patentworks window).

Regarding dependent claim 6, Rivette-749 discloses the step of extracting information further comprises the step of selecting a markup annotation from the physical page and converting the information contained in the selected markup annotation to information for use in the second window (col. 41, ll. 18-44).

Regarding dependent claim 7, Rivette-749 discloses the step of selecting further comprises the step of enclosing the markup annotation with a box (Fig. 61).

Regarding dependent claim 9, Rivette-749 discloses the second window further comprises a control panel for managing the extracted information (col. 33, ll. 64-67.).

Regarding dependent claim 10, Rivette-749 discloses the extracted information may be viewed simultaneously in a multiple of enhanced interactive windows (col. 37, ll. 39-55).

Regarding dependent claim 11, Rivette-749 discloses the visual reference on the physical page is a box with a colored border (Fig. 59).

Regarding dependent claim 12, Rivette-749 discloses the step of extracting information further comprises the step of extracting information when a computer user clicks in the first window by a selection device including a mouse and the information, which is extracted, is around the point of the mouse click (col. 25, ll. 36-43).

Regarding dependent claim 13, Rivette-749 discloses selecting a bookmark and retrieving information associated with the bookmark (col. 41, ll. 19-45).

Regarding dependent claim 14, Rivette-749 discloses retrieving information associated with a structural element when the user selects the structural element (col. 33, ll. 50-62)

Regarding dependent claim 15, Rivette-749 discloses the information emphasized by a visual reference is termed a markup annotation and each markup annotation is associated with a structural element stored in a database of structural elements (col. 4, ll. 21-37).

Regarding dependent claim 16, Rivette-749 discloses retrieving an associated structural element from a database of structural elements and displaying data from the markup annotations associated with the structural elements in the second window (col. 41, ll. 19-45).

Regarding dependent claim 17, Rivette-749 discloses enlarging and reducing visual elements (col. 36, ll. 17-34).

Regarding dependent claim 18, Rivette-749 discloses that the visual elements include graphic images, clip art, and picture objects (col. 36, ll. 17-34).

Regarding dependent claim 21, Rivette-749 discloses selecting a symbol representing extracted information in the second window, and displaying document elements associated with the symbol in the first window (col. 41, ll. 19-45).

Regarding dependent claim 22, Rivette-749 discloses that the symbol includes icons for figures (col. 36, ll. 41-46).

Regarding dependent claim 23, Rivette-749 discloses that selecting a symbol further comprises the step of enlarging or reducing a zoom view of the extracted information in the first window (col. 36, ll. 17-34).

Regarding dependent claim 24, Rivette-749 discloses that selecting a symbol displays the extracted information in a third window (col. 37, ll. 39-55).

Regarding dependent claim 25, Rivette-749 discloses that selecting a symbol displays text in another enhanced interactive window (col. 37, ll. 39-55).

Regarding dependent claim 26, Rivette-749 inherently discloses executing code as the system

of Rivette-749 is software based.

Regarding dependent claim 27, Rivette-749 discloses that document elements include

information comprising tables, figures, graphs, charts, illustration graphics, photos, clip art audio

and audiovisual elements (Fig. 59).

Regarding dependent claim 28, Rivette-749 discloses that the step of selecting includes

clicking on the symbols with a mouse (col. 41, ll. 19-45).

Regarding dependent claims 8 and 30, Rivette-749 discloses the window may be moved

anywhere (col. 46, ll. 13-30).

Regarding dependent claim 31, Rivette-749 discloses that all functions maybe accessed

without clicking (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 32, Rivette-749 discloses that the step of displaying extracted

information further comprises the step of advancing extracted information in the second window

by an action including a keystroke (col. 26, line 36 – col. 27, line 2).

Regarding dependent claim 33, Rivette-749 discloses that the step of advancing extracted

information in the second window further comprises the step of advancing the physical page

displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 34, Rivette-749 discloses that the step of advancing extracted

information in the second window further comprises the step of advancing the visual reference to

the extracted information in the physical page displayed in the first window (col. 17, ll. 17-25).

Regarding dependent claim 35, Rivette-749 discloses that the extracted information will start at

the top of the second window (Fig. 59).

Regarding dependent claim 36, Rivette-749 discloses the step of creating a summary document

from user created notes, highlights, and other user inputted information (col. 41, ll. 18-44).

Regarding dependent claim 37, Rivette-749 discloses that the step of presenting extracted

information further comprises the step of allowing the user to add to the extracted information in

the second window (col. 41, ll. 18-44).

Regarding dependent claim 38, Rivette-749 discloses that the step of presenting extracted

information further comprises the step of finding words within the second window (col. 30, ll.

26-49).

Regarding dependent claim 42, Rivette-749 discloses that the electronic information is

associated with a particular computer (col. 13, ll. 45-54).

Regarding dependent claims 43 and 55, Rivette-749 discloses that the electronic information

may be shared between computer users and between computers (col. 13, ll. 52-66).

Regarding dependent claim 45, Rivette-749 discloses selecting extracted information

represented by symbols in the second window, and displaying document elements associated

with the symbols in a third window (col. 41, ll. 19-45).

Regarding dependent claim 47, Rivette-749 discloses that the enhanced interactive window

comprises at least one window that displays extracted -Information from the physical pages (Fig.

59).

Regarding dependent claim 49, Rivette-749 discloses a database for storing annotations,

extracted electronic information, and the relationships in the system (Fig. 3, 60).

Regarding dependent claim 50, Rivette-749 discloses structure tree for storing relationship

information associating electronic information with extracted electronic information (col. 52, ll.

56-61).

Regarding dependent claim 51, Rivette-749 discloses a visual reference emphasizing the

electronic information is displayed on the physical pages (col. 4, ll. 21-37).

Regarding dependent claim 52, Rivette-749 discloses that the visual reference is a box with a

colored border (Fig. 59).

Regarding dependent claim 56, Rivette-749 discloses that the graphic images of physical pages

adhere to a page description format (Fig. 59).

Regarding dependent claim 58, Rivette-749 teaches displaying in a first window a physical

page (Fig. 59). The window surrounding the text is the visual reference. Rivette-749 teaches

extracting the information on the physical page (col. 19, line 65 – col. 21, line 11). Rivette-749

teaches presenting the extracted information in a second window and that the information is free-

flowing (Fig. 59). Rivette-749 discloses that the step of advancing extracted information in the

second window further comprises the step of advancing the physical page displayed in the first

window (col. 17, ll. 17-25).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 5,19,20,29 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over Rivette-749, and further in view of Rivette et al. (US005806079A, granted 9/8/1998)

hereinafter Rivette-079.

Regarding dependent claim 5, 29, and 48, Rivette-749 discloses the second window is an

enhanced interactive window including a thumbnail image of a physical page, a graphic image of

a physical page, text, free flowing text, icons, menus, and control elements (Fig. 59). Rivette-

749 does not explicitly disclose hyperlinks. Rivette-079 teaches hyperlinks in document browser

(col. 1, ll. 55-60). It would have been obvious to one of ordinary skill in the art at the time of the

invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

Regarding dependent claim(s) 19, Rivette-749 does not teach hyperlinks. Rivette-079 teaches

hyperlinks as described in claim 5 above. Official Notice is taken that it was well known and

desired in the art at the time of the invention to displaying hyperlinks as hypertext.

Regarding dependent claim(s) 20, Rivette-749 does not teach hyperlinks. Rivette-079 teaches

hyperlinks in document browser (col. 1, ll. 55-60) that link to documents, which are visual

elements. It would have been obvious to one of ordinary skill in the art at the time of the

invention to use hyperlinks in order to link related documents (Rivette-079, col. 1, ll. 43-54).

7.   **Claims 39-41 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Rivette-749, and further in view of Reed et al. (US005241671A, granted 8/31/1993).

Regarding dependent claims 39 and 53, Rivette-749 does not explicitly disclose a dictionary.

Reed discloses presenting a dictionary to a user to retrieve definitions (col. 14, ll. 28-40). It

would have been obvious to one of ordinary skill in the art at the time of the invention to include

a dictionary to allow the user to look up words they did not know (Reed, col. 14, ll. 28-29).

Regarding dependent claim 40, Rivette-749 does not explicitly disclose a dictionary. Reed

discloses presenting an information database to a user to retrieve definitions for unfamiliar words

(col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in the art at the time of

the invention to include a dictionary to allow the user to look up words they did not know (Reed,

col. 14, ll. 28-29).

Regarding dependent claim 41, Rivette-749 does not explicitly disclose a dictionary. Reed

discloses examining extracted information for unfamiliar words and displaying definitions for

the unfamiliar words (col. 14, ll. 28-40). It would have been obvious to one of ordinary skill in

the art at the time of the invention to include a dictionary to allow the user to look up words they

did not know (Reed, col. 14, ll. 28-29).

8.   **Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette-749.**

Regarding dependent claim 54, Rivette-749 does not explicitly disclose a lock. Official Notice

is taken that it was well-known and desirable in the art at the time of the invention to secure any

information to one device.

Double Patenting

9.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
       Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

10.   Claims 1-10, 29, 44, 46-51, and 57 are provisionally rejected under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over claims 1-

16, and 20 of copending Application No. 10/691,927 in view of Rivette-079.

The copending application teaches all elements of the instant claims except free-flowing

text. Rivette-079 teaches free-flowing text (Fig. 59). It would have been obvious to one of

ordinary skill in the art at the time of the invention to utilize free-flowing so that parts of the

document would not be cut off.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

11.   Applicant's arguments with respect to claims 1-58 have been considered but are moot in

view of the new ground(s) of rejection.

Conclusion

12.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

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